

## REMARKS

Claims 1 through 20 are extant in the case.

Examiner has rejected claims 1 through 3, 8 through 11, 15 through 18 and 20 under 35 U.S.C. § 102 (b) as being anticipated by USPN 6,201,384 B1 (Alexander). Examiner has rejected claims 4 through 7, 12 through 14 and 19 under 35 U.S.C. § 103 (a) as being unpatentable over Alexander in view of USPN 5,381,524 (Lewis). Applicant has amended the independent claims to overcome the rejections. Applicant respectfully traverses the rejection of the claims, as amended, and requests reconsideration.

Below, Applicant points out subject matter within each independent claim that is not disclosed or suggested by Alexander and Lewis, whether considered alone or in combination. On the basis of this, Applicant believes the independent claims discussed below and all the claims dependent thereon are patentable over Lewis.

### Discussion of Independent Claim 1

#### Discussion of display:

Claim 1 sets out an electronic instrument that includes a display. The display displays a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner has argued that motivation for this “rests at least in Alexander’s “pointing device”-centric implementation, where the pointer would have more use with a menu to select further features.” However, neither Alexander nor Lewis teach that the pointer in Alexander would have more use with a menu to select further features. This teaching is available only from Applicant’s Specification.

However, the courts have clearly held that for a rejection under 35 U.S.C. § 103, the prior art must provide a motivation or reason for the worker in the art, without the benefit of the applicant’s specification, to make the necessary changes in the reference device. See *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. See *In re Newell*, 891 F.2d 899, 12 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989). Both the suggestion and the expectation of success must be found in the prior art, not in the Applicant’s disclosure. *In re Dow Chemical Col.*, 837 F.2d 469, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). Examiner, therefore, has failed to find proper motivation for the suggested combination of Alexander and Lewis.

#### Discussion of logic:

Claim 1 sets out that logic within the electronic instrument allows selection of a parameter from the plurality of parameters and adjusts

values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using the pointing device. This is not disclosed or suggested by Alexander or Lewis. Neither Alexander or Lewis disclose or suggest allowing selection of a parameter from a plurality of parameters and then adjusting values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using a pointing device.

#### Discussion of Independent Claim 9

##### Displaying a menu:

Claim 9 sets out a method that includes displaying a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner has argued that motivation for this “rests at least in Alexander’s “pointing device”-centric implementation, where the pointer would have more use with a menu to select further features.” However, neither Alexander nor Lewis teach that the pointer in Alexander would have more use with a menu to select further features. This teaching is available only from Applicant’s Specification.

Examiner, therefore, has failed to find proper motivation for the suggested combination of Alexander and Lewis.

Adjusting values:

Claim 9 sets out that in response to a user selecting a parameter from the plurality of parameters and using a pointing device to select a location on the display, values for the parameter selected from the plurality of parameters are adjusted based on locations on the display selected by the user using the pointing device. Neither Alexander or Lewis disclose or suggest that in response to a user selecting a parameter from a plurality of parameters and using a pointing device to select a location on a display, values for the parameter selected from the plurality of parameters are adjusted based on locations on the display selected by the a using a pointing device.

Discussion of Independent Claim 16

Displaying a menu:

Claim 16 sets out storage media for storing software which when run on a device that has computing capability performs a method. The method includes displaying a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander

or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner has argued that motivation for this “rests at least in Alexander’s “pointing device”-centric implementation, where the pointer would have more use with a menu to select further features.” However, neither Alexander nor Lewis teach that the pointer in Alexander would have more use with a menu to select further features. This teaching is available only from Applicant’s Specification. Examiner, therefore, has failed to find proper motivation for the suggested combination of Alexander and Lewis.

Adjusting values:

Claim 16 sets out that in response to a user selecting a parameter from the plurality of parameters and using a pointing device to select a location on the display, values for the parameter selected from the plurality of parameters are adjusted based on locations on the display selected by the user using the pointing device. Neither Alexander or Lewis disclose or suggest that in response to a user selecting a parameter from a plurality of parameters and using a pointing device to select a location on a display, values for the parameter selected from the plurality of parameters are

adjusted based on locations on the display selected by the a using a pointing device.

Conclusion

Applicant believes this Amendment has placed the present Application in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

STANLEY EDWARD JAFFE

By Douglas L. Weller  
Douglas L. Weller  
Reg. No. 30,506

April 29, 2005  
Santa Clara, California  
(408) 985-0642